PTO Form 1957 (Rev 9/05)
OMB No. 0651-0050 (Exp. 04/2009)

Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	78524961
LAW OFFICE ASSIGNED	LAW OFFICE 114
MARK SECTION (no change)	
ARGUMENT(S)	

RESPONSE TO OFFICE ACTION AND REQUEST FOR RECONSIDERATION PURSUANT TO 37 C.F.R. §2.62

Sir:

The present communication is being filed in response to the office action dated February 17, 2006, a reply to which is due August 17, 2006. Also included herewith is a Notice of Appeal. Withdrawal of the rejection and reconsideration are respectfully requested.

Remarks

The application has not been amended, and is believed to be in condition for allowance to publication and registration as currently standing.

The trademark Examining Attorney has maintained refusal of registration on the Principal Register of the present mark under Trademark Act §2(e)(1), 15 U.S.C. §1052(e)(1), alleging that the mark is merely descriptive in relation to the identified goods.

This rejection is respectfully traversed, because the mark as a whole is not descriptive of the goods with which it is associated, namely, dehydrated fruit snacks. It is well established that a mark is descriptive if it describes a quality of the goods which it identifies. The Examining Attorney alleges that the mark FRUIT BUNNIES describes the specific nature and appearance of the product because the goods are in the shape of bunnies.

The primary reason for not protecting a descriptive mark is to prevent the owner of a mark from inhibiting competition in the sale of particular goods, and to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing

infringement suits by the registrant against others who use the mark when advertising or describing their own products. See TMEP Section 1209.

In the present case, the goods being sold are dehydrated fruit snacks. This is evident by the description of goods included in the application, which specifically lists international class 29, and further identifies dehydrated fruit snacks as the goods within this class. Neither bunnies nor rabbits are the goods with which the mark is associated. The mark FRUIT BUNNIES is not, nor is it alleged to be, descriptive of such snacks. The bunny shape is a trade dress of applicants and is a fanciful design used to identify the goods being sold.

The Examining Attorney further asserts that since the trade dress of Applicant is a bunny shaped fruit snack, it is a product design which is inherently not distinctive. The examining attorney then further extends this logic to assume that a word mark associated with trade dress is somehow tainted by the inherent non-distinctiveness of the product design to render it non-registerable.

Applicant respectfully disagrees. While it is settled law that a product design may not be inherently distinctive (*Wal-Mart Stores Inc. v. Samara Brothers Inc.*, 529 U.S. 205 (2000)), it does not follow and there is no support for the proposition that a word mark associated with such trade dress is also inherently non-distinctive. It is worth noting that it is not certain whether the bunny-shaped fruit snack is a product design of another type of trade dress, but even assuming it is a product design, a trademark associated with the product design cannot be inherently non-descriptive.

The Examining Attorney, in fact, did not reject the word mark on a descriptiveness basis until Applicant made clear its trade dress, i.e., that its dehydrated fruit snacks are bunny shaped. The Examining Attorney is therefore rejecting the mark on a basis that the mark describes the trade dress, and not the product itself. This is contrary to established caselaw, which indicates that the mark must describe the goods or a quality of the goods. Trade dress is not a quality of the goods.

Registration of the mark FRUIT BUNNIES certainly would not inhibit competition of the sale of dehydrated fruit snacks, and would maintain freedom to the public use of the language, as "bunnies" is a term not used to describe fruit snacks. "Bunnies", in fact, is a fanciful and arbitrary term when used to identify such snacks.

The term FRUIT BUNNIES, therefore, is not descriptive of dehydrated fruit snacks, and the composite term FRUIT BUNNIES creates a unique non-descriptive mark when used to identify dehydrated fruit snacks. The shape of the snacks is also a trade dress of Applicant, and as such should not be used to prevent registration for a word mark covering dehydrated fruit snacks.

Based on the remarks above, withdrawal of the rejection and reconsideration are respectfully requested. Having responded in full to the outstanding office action, it is

respectfully submitted that the present application is in condition for publication. Favorable action thereon is respectfully requested.

A Notice of Appeal preserving applicant's right to Appeal will be filed with the TTAB contemporaneous with this Response. Should the trademark examining attorney have any questions regarding this application, the undersigned would be pleased to address them by telephone.

SIGNATURE SECTION	
RESPONSE SIGNATURE	/mark e. baron/
SIGNATORY NAME	Mark E. Baron
SIGNATORY POSITION	Trademark Attorney
SIGNATURE DATE	08/17/2006
FILING INFORMATION SECTION	
SUBMIT DATE	Thu Aug 17 16:43:32 EDT 2006
TEAS STAMP	USPTO/ROA-12.4.231.134-20 060817164332192875-785249 61-3401da11877cdf7e658729 cf4f50c582f6-N/A-N/A-2006 0817163936422469

PTO Form 1957 (Rev 9/05)

OMB No. 0651-0050 (Exp. 04/2009)

Response to Office Action

To the Commissioner for Trademarks:

Application serial no. **78524961** has been amended as follows:

Argument(s)

In response to the substantive refusal(s), please note the following:

RESPONSE TO OFFICE ACTION AND REQUEST FOR RECONSIDERATION PURSUANT TO 37 C.F.R. §2.62

Sir:

The present communication is being filed in response to the office action dated February 17, 2006, a reply to which is due August 17, 2006. Also included herewith is a Notice

of Appeal. Withdrawal of the rejection and reconsideration are respectfully requested.

Remarks

The application has not been amended, and is believed to be in condition for allowance to publication and registration as currently standing.

The trademark Examining Attorney has maintained refusal of registration on the Principal Register of the present mark under Trademark Act §2(e)(1), 15 U.S.C. §1052(e)(1), alleging that the mark is merely descriptive in relation to the identified goods.

This rejection is respectfully traversed, because the mark as a whole is not descriptive of the goods with which it is associated, namely, dehydrated fruit snacks. It is well established that a mark is descriptive if it describes a quality of the goods which it identifies. The Examining Attorney alleges that the mark FRUIT BUNNIES describes the specific nature and appearance of the product because the goods are in the shape of bunnies.

The primary reason for not protecting a descriptive mark is to prevent the owner of a mark from inhibiting competition in the sale of particular goods, and to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products. See TMEP Section 1209.

In the present case, the goods being sold are dehydrated fruit snacks. This is evident by the description of goods included in the application, which specifically lists international class 29, and further identifies dehydrated fruit snacks as the goods within this class. Neither bunnies nor rabbits are the goods with which the mark is associated. The mark FRUIT BUNNIES is not, nor is it alleged to be, descriptive of such snacks. The bunny shape is a trade dress of applicants and is a fanciful design used to identify the goods being sold.

The Examining Attorney further asserts that since the trade dress of Applicant is a bunny shaped fruit snack, it is a product design which is inherently not distinctive. The examining attorney then further extends this logic to assume that a word mark associated with trade dress is somehow tainted by the inherent non-distinctiveness of the product design to render it non-registerable.

Applicant respectfully disagrees. While it is settled law that a product design may not be inherently distinctive (*Wal-Mart Stores Inc. v. Samara Brothers Inc.*, 529 U.S. 205 (2000)), it does not follow and there is no support for the proposition that a word mark associated with such trade dress is also inherently non-distinctive. It is worth noting that it is not certain whether the bunny-shaped fruit snack is a product design of another type of trade dress, but even assuming it is a product design, a trademark associated with the product design cannot be inherently non-descriptive.

The Examining Attorney, in fact, did not reject the word mark on a descriptiveness basis until Applicant made clear its trade dress, i.e., that its dehydrated fruit snacks are bunny

shaped. The Examining Attorney is therefore rejecting the mark on a basis that the mark describes the trade dress, and not the product itself. This is contrary to established caselaw, which indicates that the mark must describe the goods or a quality of the goods. Trade dress is not a quality of the goods.

Registration of the mark FRUIT BUNNIES certainly would not inhibit competition of the sale of dehydrated fruit snacks, and would maintain freedom to the public use of the language, as "bunnies" is a term not used to describe fruit snacks. "Bunnies", in fact, is a fanciful and arbitrary term when used to identify such snacks.

The term FRUIT BUNNIES, therefore, is not descriptive of dehydrated fruit snacks, and the composite term FRUIT BUNNIES creates a unique non-descriptive mark when used to identify dehydrated fruit snacks. The shape of the snacks is also a trade dress of Applicant, and as such should not be used to prevent registration for a word mark covering dehydrated fruit snacks.

Based on the remarks above, withdrawal of the rejection and reconsideration are respectfully requested. Having responded in full to the outstanding office action, it is respectfully submitted that the present application is in condition for publication. Favorable action thereon is respectfully requested.

A Notice of Appeal preserving applicant's right to Appeal will be filed with the TTAB contemporaneous with this Response. Should the trademark examining attorney have any questions regarding this application, the undersigned would be pleased to address them by telephone.

Response Signature
Signature: /mark e. baron/ Date: 08/17/2006
Signatory's Name: Mark E. Baron
Signatory's Position: Trademark Attorney

Serial Number: 78524961
Internet Transmission Date: Thu Aug 17 16:43:32 EDT 2006
TEAS Stamp: USPTO/ROA-12.4.231.134-20060817164332192
875-78524961-3401da11877cdf7e658729cf4f5
0c582f6-N/A-N/A-20060817163936422469